

REMARKS

The applicant respectfully requests entry of the foregoing amendment, and reconsideration of claims 27-44, 46-75, 78-79, 81-83, and 85-94 in view of that amendment.

The foregoing amendment includes changes to claims previously presented, as follows:

1. Claim 29 is amended to incorporate the subject matter of claim 45, which now is cancelled.
2. Claim 65 is amended to incorporate the subject matter of claim 80, which now is cancelled.
3. Claim 68 is amended to incorporate the subject matter of claim 84, which now is cancelled.
4. Claim 72 is amended to incorporate the subject matter of claims 76 and 77, which now are cancelled.

Now, with respect to the matters raised in the present action:

- A. Claims 29, 60, 65-68, 71-75, 78-79, 83 and 87 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,411,535 (Fujii, et al.).

As noted above, claim 29 has been amended to incorporate the subject matter of claim 45. Claim 65 has been amended to incorporate the subject matter of claim 80. Claim 68 has been amended to incorporate the subject matter of claim 84. Finally, claim 72 has been amended to incorporate the subject matter of claims 76 and 77.

Claims 45, 80 and 84 are subject to a rejection as noted below. However, the rejection is overcome by the accompanying supplemental declaration. Claims 76 and 77 have been indicated as incorporating allowable subject matter.

Accordingly, it is submitted that the foregoing amendment places independent claims 29, 65, 68 and 72 in condition for allowance. The remaining claims subject to this rejection depend on one of these independent claims, and therefore also are in condition for allowance.

- B. Claims 29, 43-46, 59-60, 62, 68-70 and 79-94 have been rejected as being based upon a defective reissue oath or declaration under 35 U.S.C. § 251.

Enclosed is a supplemental declaration, signed by Peter A. Altman as the applicant, covering the errors which have been corrected in the present reissue application and not covered by any prior oath or declaration. Accordingly, it is submitted that the rejection of claims as based on a defective reissue oath or declaration, is overcome.

C. Claims 91 and 93 are potentially subject to an objection under 37 CFR 1.75 as being substantial duplicates of claims 43 and 59, respectively.

Pursuant to the foregoing amendment, claims 43 and 59 have in effect been amended to incorporate the subject matter of claim 45 (now cancelled), due to their dependency on claim 29. Accordingly, it is submitted that claims 91 and 93 no longer duplicate claims 43 and 59, respectively.

The indication that claims 27, 28, 30-42, 47-57, 61, 63 and 64 are allowed, is noted and appreciated.

In summary, it is submitted that claims 27-44, 46-75, 78-79, 81-83 and 85-94 define subject matter patentable over the prior art of record. The foregoing amendment does not introduce new matter, does not touch upon the merits of the application, nor does it require further consideration or searching on the part of the examiner. Rather, the amendment places the claims in condition for allowance. Accordingly, the applicant respectfully requests entry of the amendment and allowance of the pending claims.

Respectfully submitted,

Biocardia, Inc.

Dated: May 9, 2005

By: 
Frederick W. Niebuhr
Registration No. 27,717
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Patent Application

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. of Altman, Peter A. Art Unit: 3739
Serial No.: 10/014,445 Examiner: Lee S. Cohen
Filed: December 11, 2001 Atty Docket No.: 23,403-05
Reissue of: U.S. Patent No. 5,551,427
For: Implantable Device for Penetrating and Delivering Agents to Cardiac Tissue

REISSUE APPLICATION – SUPPLEMENTAL DECLARATION

As the below-named inventor and applicant for reissue of the above identified U.S. patent, I hereby declare that:

My residence, post office address, and citizenship are as stated immediately below next to my name:

Full name of inventor: Peter A. Altman
Residence (City/State): San Francisco, California
Mailing Address: 5243 California Street
San Francisco, CA 94118
Citizenship: United States

I believe I am the original, first, and sole inventor of the subject matter described and claimed in U.S. Patent No. 5,551,427, granted September 3, 1996 on U.S. Application Serial No. 387,257 filed February 13, 1995, and for which a reissue patent is sought on the invention entitled Implantable Device for Penetrating and Delivering Agents to Cardiac Tissue, the specification of which has been amended, most recently by the accompanying Amendment Pursuant to 37 C.F.R. 1.116.

I have reviewed and understand the contents of the above identified specification, including the claims (original claims 1-26 and new claims 27-94) as amended or cancelled by said accompanying Amendment and any previous amendment.

I acknowledge the duty to disclose information material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56.

With regard to surrender of the patent pursuant to 37 C.F.R. 1.178, I hereby confirm that the original Certificate of U.S. Letters Patent No. 5,551,427 has been surrendered in reissue application Serial Number 09/146,120 for reissue of said U.S. Patent No. 5,551,427.

I believe the original patent to be partly inoperative or invalid by reason of my claiming less than I had a right to claim in the original patent.

In particular, the claims of the original patent are directed to a biocompatible, electrically inactive, implantable device including a means for penetrating cardiac tissue to effect an implantation of the implantable device at a designated site in a heart, to modify electrical action in the cardiac tissue at and proximate the site (claim 21). The claims in the original patent also are directed to a method of locally altering electrical activity in cardiac tissue at a selected site in the region of the heart, including: measuring electrical activity in cardiac tissue, to identify a potential implantation site; and introducing an electrically inactive and biocompatible implantable device into the region of the heart, and at least partially imbedding the implantable device into cardiac tissue at the site to effect an implantation (claim 12).

I believe that the original patent, in particular at column 6 lines 9-16, column 6 lines 61-67 and at column 14 lines 25-39 when considered in conjunction with the drawings and with the remainder of the specification, discloses a further aspect of the invention relating to the use of a structure having a tissue penetrating element for delivering a pharmacological agent, more particularly an angiogenic agent, to cardiac tissue at and adjacent the penetrating element. The invention further relates to a process for delivering a pharmacological agent, more particularly an angiogenic agent to the heart, by penetrating a delivery device into heart tissue and delivering the agent to the tissue through the delivery device.

Based on my further consideration of the claims of the original patent, and consultation with my patent attorneys and others concerning the patented claims, I now believe that the original patent claims do not sufficiently claim the aforementioned further aspect of the invention. The aforementioned reissue application serial number 09/146,120, issued December 11, 2001 as Reissue Patent number Re. 37,463, addresses this error. New claims 27-94 of the present reissue

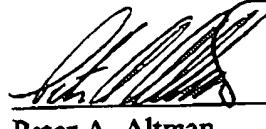
application as amended, filed December 11, 2001 as a divisional of said reissue application serial number 09/146,120, are intended to further address this error.

Every error in the patent which has been corrected in the present reissue application as amended, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Wherefore, I hereby petition for a reissue of U.S. Patent No. 5,551,427 under 35 U.S. Code Section 251 in accordance with the aforementioned specification and claims, and I hereby subscribe my name to said specification and claims and to this declaration, and petition.

Date: 9 May 2005


Peter A. Altman

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